

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Minor amendments have been made to the specification and claims. Applicant submits that these amendments do not introduce new matter. An early notice to that effect is earnestly solicited.

Claims 1-14 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicant has corrected "cable" in claim 1, line 6. With respect to the alleged discrepancy between claims 1 and 2, Applicant points out that claim 2, lines 1-2, recites "wherein the adhesive bonding of the at least one double-sided adhesive tape section *to the flat ribbon cable.*" Consequently, claim 2 does also require that the adhesive is bonded to the cable. In accordance with this purpose, "substrate" has been replaced at both occurrences in claim 2 by -- cable --. In view of the foregoing, Applicants submit the claims are definite. An early notice to that effect is earnestly solicited.

Claims 1, 9, 10, 13 and 14 were rejected under 35 USC § 103(a) as being obvious over Europe 046 (EP 1233046) in view of admitted prior art (page 2 lines 13-28) and Japan 535 (JP 2002-101535). In response, Applicant submits that the cited combination does not make out a *prima facie* case of the obviousness of the instant claims. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

In the middle of page 3 of the Office Action, the Examiner concedes that the primary reference, Europe 046, does not teach either (1) applying double-sided adhesive tape sections to a flat ribbon cable or (2) bringing the flat ribbon cable and a substrate together to bond the flat ribbon cable to the substrate. With respect to (1), Applicant would point out that although Europe 046 mentions flat cable as a part that can be bonded

to a substrate with an adhesive tape section, Europe 046 does not appear to specify whether the adhesive tape section is applied first to the flat cable or the substrate, and, thus, does not teach that at least one double-sided adhesive tape section is applied to the flat ribbon cable, as required by instant claim 1, step b).

With respect to (2), Applicant points out that the Examiner has sort of summarized what he perceives to be the gist of claim 1, steps c) and d). However, Applicant submits that these should be kept separate, and that the actual wording need be dealt with. Thus, Europe 046 also does not teach (2) moving the flat ribbon cable and the substrate relative to one another, or (3) adhesively bonding the flat ribbon cable to the substrate by the at least one double-sided adhesive tape so that when the mount is removed from the substrate the flat ribbon cable is detached from the mount. Indeed, the Examiner doesn't even allege that Europe 046 teaches a mount, much less that the grip of the mount on the flat cable is less than the adhesion between the substrate and the flat cable so that the cable is separated from the mount and remains bonded to the substrate when the mount is removed.

The question for obviousness is this: Is there a suggestion in the allegedly admitted prior art and the combination with Japan 535 that bridges all three gaps in such a way that a person skilled in the art would have been directed to the present invention? Applicant thinks not.

At the bottom of page 3 of the Office Action, the Examiner says it would have been obvious to apply the double-sided adhesive tape section to the flat ribbon cable. However, the Examiner's statement alone is insufficient; there must be a teaching and suggestion in the relied upon prior art. As the Federal Circuit noted in *In re Sang-Su Lee*, "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" The Board's findings must extend to all material facts and must be documented on the record." See *In re Sang-Su Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Applicant submits that there is no suggestion in Europe 046 to apply the adhesive tape section to the flat ribbon cable, and,

moreover, the only pertinent piece of prior art relating to an analogous adhesive application, Japan 535, actually teaches away from such procedure by applying the adhesive *to the substrate*, not the flat cable, and, then, *as a spray*, not an adhesive tape section. Consequently, there is no support on the present record for the Examiner's theory that it would have been obvious to apply the double-sided adhesive tape section to the flat ribbon cable. Since no prior art reference of record supports the Examiner's position, it is impermissible hindsight, as a matter of law. *Lee, id.* Thus, nothing in the cited combination of references teaches or suggests item (1) above.

With respect to element (2), the Examiner says this is taught by Japan 535. However, as noted above, in Japan 535, the substrate has the adhesive applied to it, not the flat cable. Consequently, this arrangement is different than that required by item (2) above, wherein a flat cable, to which an adhesive has been applied, is moved and/or receives a moving substrate. Consequently, the cited combination of references fails to teach or suggest item (2) above.

Finally, with respect to element (3), even assuming for the sake of argument that this was taught by Japan 535—which Applicant does not concede—the fact of the matter is that the combination of references still would be missing elements (1) and (2), and, thus, no *prima facie* case of obviousness would have been made out. Under no circumstances does the cited combination of references lead persons skilled in the art to the present invention.

In short, in view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 2-8 were rejected under 35 USC § 103(a) as being obvious over Europe 046 in view of admitted prior art, and Japan 535 and further in view of Schwertfeger, US 2005/056378. In response, the undersigned hereby states that at the time the present invention was made, Schwertfeger and the instant application were commonly owned or

subject to an obligation of assignment to the same person, namely tesa AG. Since Schwertfeger qualifies as prior art only under 35 USC § 102(e), pursuant to 35 USC § 103(c), Schwertfeger is removed as prior art. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection as well.

Claims 2-5 and 8 were rejected under 35 USC § 103(a) as being obvious over Europe 046 in view of admitted prior art, and Japan 535 and further in view of German 249 (DE 2617249) and optionally Hamisch (US 6138734).

Claim 6 was rejected under 35 USC § 103(a) as being obvious over Europe 046 in view of admitted prior art, and Japan 535 and further in view of German 249 and optionally Hamisch and further in view of Samuelson et al (US 5316613).

Claim 7 was rejected under 35 USC § 103(a) as being obvious over Europe 046 in view of admitted prior art, and Japan 535 and further in view of German 249 and optionally Hamisch and further in view of German 602 (DE 3834602).

Claims 11 and 12 were rejected under 35 USC § 103(a) as being obvious over Europe 046 in view of admitted prior art, and Japan 535 and further in view of Barck (US 4126304).

In response to each of the previous four obviousness rejections, Applicant points out that the defects in the combination of Europe 046, the admitted prior art and Japan 535 are discussed above. There is nothing in the other cited references that overcomes these effects, or is even alleged to overcome these defects. Consequently, none of these combinations makes out a prima facie case of the obviousness of the instant claims. Therefore, Applicant respectfully requests that the Examiner withdraw each of these rejection as well.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
NORRIS MCLAUGHLIN & MARCUS, P.A.

By 

Kurt G. Briscoe
Attorney for Applicant(s)
Reg. No. 33,141
875 Third Avenue - 18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844